

**Docket 85538AEK  
Customer No. 01333**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of  
Paul B. Merkel et al

Filed 18 July 2003

Image-Recording Element With  
Fluorosurfactant And Colloidal  
Particles

Group Art Unit: 1774

Serial No. 10/622,421  
Appeal No. 2008-5705

Examiner: Pamela R. Schwartz

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR REHEARING**

In response to the Decision on Appeal decided December 17, 2008, Appellants hereby request a Rehearing. This request is focused on Issue 4 as described in the mentioned Decision. In particular, it is believed that the Board overlooked or misapprehended a point of fact related to cited reference US 6,495,242 of Tsuchiya.

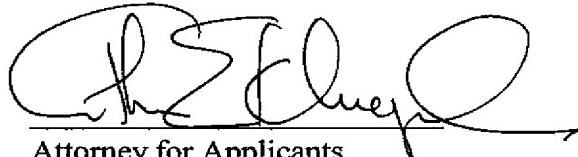
In the Analysis section of the Decision, at page 12, the last paragraph before the "Conclusions of Law," it is stated "The portion of Tsuchiya relied on by the Appellants relates to a comparative example. See Tsuchiya 11:1-3." This statement suggests a misunderstanding of the reference as a whole.

Turning to Tsuchiya, at 13:66-67; 14:63-64; 15:27; and 15:66, it is clear that the statement about pH value in the reference examples applies not only to the comparative example but also to all of the working examples of the invention. Thus, all of the "preferred embodiments" of Tsuchiya are obtained using materials of pH 2.6 and 2.3 to provide a dispersion that is strongly acidic.

Considering the fact that all of the rejections in this case are based on obviousness under section 103 and not novelty under section 102, the Board should not rely on adventitious disclosure. The gist of all of the references is that an acidic dispersion is preferred and this is borne-out in the examples of the citations. While Nakano mentions a pH upper limit of 8, all of his "preferred embodiment" examples are strongly acidic at pH 3.5. Niu is silent on any broad range of pH except to say that a range of 3-6 is preferred. Although the pH of an aqueous dispersion and that of a water-wetted surface of a dried coating of that dispersion may not be identical, it would clearly be expected that a highly acidic coating would provide a highly acidic surface water-wetted pH. If the present invention is viewed as a patent of selection, it cannot be said that there is any genuine guidance to one of ordinary skill in the art to select a surface pH "between 8 and 10" from the cited three references, each of which clearly directs one to a highly acidified dispersion. A prima facie case has not been established from the cited references that one of ordinary skill in the art would have expected an advantage from employing a pH between 8 and 10.

In view of the foregoing, it is requested that the Board reverse the Examiner's rejection and mandate the allowance of Claim 33.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

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